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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/017,311      | 10/30/2001  | Jeffery O. Burrell   | 60027.0051US01      | 7213             |

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BELLSOUTH CORPORATION  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

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| EXAMINER |
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O'CONNOR, GERALD J

|          |              |
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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,311

Applicant(s)

Burrell et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on May 16, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 30, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050307</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Preliminary Remarks*

1. This Office action responds to the amendment of claim 1 and the arguments filed by applicant on May 16, 2005 in reply to the previous Office action, mailed February 10, 2005.

### *Claim Rejections - 35 USC § 101*

2. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-14 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to *require* the use of any technology, such as claims 1-14, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation *in the body of the claim* is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art, as described in the background section of the specification on pages 1 and 2.

The admitted prior art includes all of the elements of claims 1-6 and 14 because, notwithstanding their being styled as “computer-implemented,” the claims read merely on the known manual method of maintaining an inventory record for inventory having various locations and performing a periodic manual inventory update to correct/reconcile any discrepancies in the inventory record as the accuracy of the record diminishes over time. Note that all claimed features are either explicitly described by the admitted prior art, or else would necessarily, thus inherently, be performed in practicing the method described by the admitted prior art. Note too, that the invention, *as claimed*, requires no computer or other apparatus whatsoever to be performed, the claims reading merely on the recited steps being performed manually.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-13 and 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the background section of the specification on pages 1 and 2.

The admitted prior art describes a method of reconciling a current central inventory record having counts and location assignments for a plurality of product types, as applied above in the rejection of claims 1 and 6 under 35 U.S.C. 102(a), but the admitted prior art fails to include the steps of removing outlier values from the data; averaging the remaining data values; and, using the calculated average as the adjustment amount when the current inventory data needs to be updated/adjusted/corrected due to a discrepancy in the count of items, as determined by an updated inventory assessment, rather than simply using the oldest/earliest value and using that value without regard as to whether or not the value was obviously erroneous.

However, FIFO, LIFO, average, and weighted average are four well known, hence obvious, techniques to use in the valuation of inventory. Furthermore, excluding obviously erroneous, mis-keyed data to improve the accuracy of results when averaging data is also a well known, hence obvious, technique to use when calculating a statistical average.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method described in the admitted prior art, so as to periodically perform necessary corrections/adjustments/updates to inventory based on inventory valuation calculated on an average basis, rather than a FIFO basis, as is well known to do, and to exclude clearly erroneous, mis-keyed data when calculating the average, as is also well-known to do, in order to produce an accounting of inventory that would be as accurate as possible, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 8, 9, 12, and 13, the further details of these dependent claims would all be either inherent in the described combination, or else self-evident or well known, hence obvious, to one of ordinary skill in the art, such that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made any necessary modifications, merely as a matter of design choice, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 10 and 11, the admitted prior art does not include making substitutions of inventory for interchangeable parts to offset a surplus of one with a shortage of another, based on a substitution table to indicate interchangeability of parts. However, storing a list of interchangeable parts in a table and making substitutions of interchangeable parts to offset a shortage of one with a surplus of another is a well known, hence obvious, technique to employ in performing an accounting of inventory. For example, if 60 Energizer AA batteries and 40

Duracell AA batteries are later determined to instead be 60 Duracells and 40 Energizers, there are still 100 AA batteries. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of the admitted prior art so as to provide a substitution table of interchangeable parts and make substitutions of interchangeable parts to offset a shortage of one with a surplus of another, as is well known to do, in order to minimize the amount of adjustments being made to correct the inventory, thereby improving the accuracy, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 15-26, drawn to apparatus for performing, in an automated fashion, the methods/functions of claims 1-14, the admitted prior art does not include that any known apparatus is capable of performing, in an automated fashion, the methods described by the admitted prior art. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided apparatus such as recited by claims 15-26, since the underlying method steps/functions being performed by the apparatus are themselves either known or considered obvious, as set forth in the rejections of claims 1-14 hereinabove, and because it has been held that broadly providing a mechanical or automatic means to replace manual activity which would accomplish the same result involves only routine skill in the art.

*In re Venner*, 120 USPQ 192.

*Response to Arguments*

8. Applicant's arguments filed May 16, 2005 have been fully considered but are not persuasive.

9. Regarding the argument concerning the newly added recitation "computer-implemented," the recitation "computer-implemented" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. Regarding the argument that the admitted prior art system leaves the location assignment for write-ons unresolved, the admitted prior art system includes that, "When a write-on occurs in the central inventory record, a location assignment *must* be provided for each instance being added to the count." (Emphasis added.) See, in particular, page 2, lines 7-9. Therefore, since location assignments "must" be provided in order to perform the write-on, location assignments are indeed clearly provided and no location assignments are left unresolved.

11. Regarding the argument that the admitted prior art system chooses the location assignment arbitrarily for write-offs, the admitted prior art system includes that, "When a write-



off occurs in the central inventory record, an instance to be removed *must* be chosen from the set of instances having various location assignments.” (Emphasis added.) See, in particular, page 2, lines 14-15. Therefore, since a particular instance “must” be chosen in order to perform the write-off, any person of ordinary skill in the art would instantly and unquestionably recognize that the particular instance to be chosen would be one of the instances having the same location assignment as where the shortage of inventory was discovered when the periodic recount was performed, as it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

12. Regarding the further arguments with respect to anticipation of the dependent claims, it is axiomatic that a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978). One of ordinary skill in the art would certainly understand, for example, the if a particular location was two pieces short of a particular part, two instances in the central inventory record, both having that same particular location, would need to be written off, in order to correct the database records.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

August 1, 2005

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(8-1-05)" in parentheses.

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627